UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL R. ANDERSON

Appeal No. 2006-2060
Application No. 10/605,873
Technology Center 3700

ON BRIEF

Before FRANKFORT, NAPPI and HORNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the examiner's final rejection of claims 1-5. On page 9 of the Answer, the examiner withdrew the rejection of claim 6 and indicated that it would be allowable if rewritten in independent form.

We affirm in part.

BACKGROUND

The appellant's invention relates to a capsule that contains liquid and/or dry material to be subsequently dispensed into a container. The capsule body includes a first member (12) and a second member (20). The first member (12) has an open top and a sealed closed bottom (12b). (Specification, para. [0041] and Figure 1). The second member (20) has a sealed closed top and an open bottom with a cutting element. The cutting element includes two prongs (24, 26) and a cutting edge (20a) disposed between the prongs. (Specification, para. [0043] and Figures 3-6). The first member (12) can be moved relative to the second member (20) so that the prongs (24, 26) and the cutting edge (20a) cut open the sealed closed bottom (12b) of the first member (12). (Specification, para. [0043]). Claim 1 is representative of the subject matter on appeal. A copy of all of the claims on appeal can be found in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

English	1,774,258	Aug. 26, 1930
Bowes *et al.* (Bowes)	3,156,369	Nov. 10, 1964
Rizzardi	5,038,951	Aug. 13, 1991

The following rejections are before us for review.

1. Claims 1, 2, and 4 stand finally rejected under 35 U.S.C. § 102(b) as anticipated by English.
2. Claims 1-4 stand finally rejected under 35 U.S.C. § 103(a) as unpatentable over Bowes in view of English.
3. Claim 5 stands finally rejected under 35 U.S.C. § 103(a) as unpatentable over Bowes in view of English and Rizzardi.

Rather than reiterate in detail the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer (mailed December 22, 2005) for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed November 16, 2005) and reply brief (filed February 13, 2006) for the appellant's arguments.

OPINION

In reaching our decision in this appeal, we have carefully considered the appellant's specification and claims, the applied prior art, and the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations that follow.

Turning first to the rejection of claims 1, 2, and 4 as being anticipated by English, the examiner has determined that English discloses a capsule with a capsule body having a first member (4) and a second member (9) and that meets all of the limitations of claims 1, 2, and 4. (Examiner's Answer, p. 3-4).

The appellant, on page 5 of the brief, appears to distinguish the English reference noting that in English the cutters penetrate partition (4) and the sections (2 and 3) are then turned relative to one another to cause the partition to be cut loose from its flange. The appellant argues that in the claimed invention, it is the cutting edge of the second member that tears open the sealed closed bottom of the first member allowing the entire contents to be released from the capsule completely. To the extent that the appellant is arguing that English fails to disclose "a cutting edge disposed between said first prong and said second prong," as recited in claim 1, we agree. It is clear from the description on page 2, lines 10-16 of English that

the cutters (12) of English must be rotated to cut the partition from the flange. As such, the capsule of English does not appear to have a cutting edge like that claimed by the appellant on its second member. Accordingly, we do not sustain the rejection of claims 1, 2, and 4 as being anticipated by English.

Turning next to the rejection of claims 1-4 as being unpatentable over Bowes in view of English, the examiner has determined that Bowes discloses all of the elements of claim 1 except for the cutting element comprising a first prong and a second prong disposed along a peripheral edge of the second member and having a cutting edge disposed between the prongs. The examiner finds that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cutting element of Bowes with two prongs as taught in English "to facilitate cutting the closed bottom of the first member." (Examiner's Answer, pp. 5 and 7). The appellant argues: (1) there is no motivation to combine the references; (2) there is no teaching in either reference to modify the device of Bowes with the cutters of English; and (3) even if a person of ordinary skill in the art combined Bowes with English, one would not arrive at the claimed invention. (Appellant's Brief, p. 6 and Appellant's Reply Brief, p. 4).

The requirement of a showing of a "teaching, suggestion, or motivation" to modify or combine the prior art teachings was recently described in *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006),

> [T]he "motivation-suggestion-teaching" test asks not merely what the references disclose, but whether a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in

> the claims. From this it may be determined whether the overall disclosures, teachings, and suggestions of the prior art, and the level of skill in the art – i.e., the understandings and knowledge of persons having ordinary skill in the art at the time of the invention- support the legal conclusion of obviousness. (internal citations omitted).

For the reasons discussed below, we find that a person of ordinary skill in the art, possessed with the understandings and knowledge reflected in the prior art, and motivated by the general problem facing the inventor, would have been led to make the combination recited in the claims.

We first consider the problem facing the inventor. "In considering motivation in the obviousness analysis, the problem examined is not the specific problem solved by the invention but the general problem that confronted the inventor before the invention was made. *Kahn*, 441 F.3d at 988, 78 USPQ2d at 1336 (citations omitted). In this case, the general problem confronting the inventor was to devise a system for separate storage and subsequent mixing of two products.

With regard to the appellant's argument that there is no teaching in English or Bowes to provide the cutting edge between the prongs or cutters (Appellant's Brief, p. 6), we find this argument unpersuasive because, the references being combined do not need to explicitly suggest combining their teachings to establish a prima facie case of obviousness. *See e.g., In re Johnston*, 435 F.3d 1381, 1385, 77 USPQ2d 1788, 1790-91 (Fed. Cir. 2006) (*citing Medical Instrumentation and Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1221-22 (Fed. Cir. 2003)) ("[t]he suggestion or motivation to combine references does not have to be stated expressly; rather it may be shown by reference to the prior art itself, to the nature

of the problem solved by the claimed invention, or to the knowledge of one of ordinary skill in the art."); and *Kahn*, 441 F.3d at 987-88, 78 USPQ2d at 1337-38 ("the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references"). In fact, an explicit teaching that identifies and selects elements from different sources and states that they should be combined in the same way as in the invention at issue, is rarely found in the prior art. *Johnston*, 435 F.3d at 1385, 77 USPQ2d at 1790-91.

As such, we examined whether the prior art explicitly or implicitly suggested the claimed combination. "'The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.'" *Kahn,* 441 F.3d at 987-88, 78 USPQ2d at 1336 (*quoting In re Kotzab,* 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

The appellant argues that the cutters in English operate differently from the cutting edge of Bowes, and as such, it is "highly unlikely that a person of ordinary skill in the art would see an obvious combination of the two patents." (Appellant's Reply Brief, p. 4). With regard to the operation of English, the appellant argues that the capsule has no cutting edge between the cutters (12) and instead requires the user to rotate the cutters (12) to cut the partition (4) away from flange (4). (Appellant's Reply Brief, p. 3). With regard to Bowes, the appellant argues that the cutting edge (29) of the cutting cylinder (27) operates by first piercing the flat bottom (16) at the one lowest point and then proceeds to cut around the edge of the flat bottom (16) because of its cylindrical shape. (Appellant's Reply Brief, p. 4). While we recognize these differences in the operation of the two cutting

mechanisms, we do not see how one teaches away from the other or would have led one of ordinary skill not to have combined their teachings. Rather, we find that because both of the references are directed to solving the same problem of separately storing two products for subsequent mixing and both solved the problem similarly by using a capsule with a plunger on one part to puncture a sealed bottom of another part, that one of ordinary skill would have had sufficient motivation to combine their teachings.

The appellant contends that, in operation, the cutting edge of Bowes would separate the flat bottom (16) completely from the cup (15). (Appellant's Brief, p. 6). We disagree. As is clearly shown in phantom in Figure 3 and described in col. 3, lines 60-71 of Bowes, "[a]s the downward movement of the plunger 26 continues, the cutting cylinder 27 cuts further through the cup *until finally the bottom 16 of the cup swings downwardly* . . . to open up the bottom of the cup and allow its contents to fall into the mixing container 11." As such, Bowes clearly discloses that due to the inclined surface of the cutting cylinder (27), the bottom (16) remains attached to the cup when the plunger (26) reaches its fully depressed position. We further find that Bowes has one prong or cutter at the lowermost point (34) of the inclined cutting edge (29). (Bowes, col. 3, lines 60-65).

Based on our understanding of the operation of Bowes and English, we agree with the examiner that there would have been sufficient motivation for a person of ordinary skill in the art to have modified the cutting edge of Bowes to add another prong (in addition to the prong at the lowermost point 34) to facilitate initial penetration and cutting of the bottom of the cup. We find that the prior art relied on by the examiner is directed to the same general problem that was confronting the

inventor and that the Bowes reference is remarkably similar to the claimed invention except for the missing second prong. A person of ordinary skill in the art, possessed with knowledge of the Bowes device, would have quickly realized that it would be advantageous to use two or more prongs, which English teaches for use for the same purpose of cutting through a sealed bottom of capsule member, on the inclined cutting surface of the Bowes device, to facilitate the initial cut through the sealed bottom. As such, we find sufficient motivation to modify the device of Bowes with the teachings of English.

Finally, with regard to the appellant's argument that even if a person of ordinary skill in the art combined Bowes with English, one would not arrive at the claimed invention (Appellant's Reply Brief, p. 4), without further explanation from the appellant, we fail to see how this is the case. To modify Bowes to facilitate cutting of the sealed bottom, one needs to merely add another prong to the inclined cutting edge. Such a modification is simple and would clearly arrive at the claimed invention.

The appellant does not separately argue the patentability of dependent claims 2-4, but relies instead on the arguments for patentability of claim 1. Accordingly, we sustain the rejection of claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Bowes in view of English.

Turning lastly to the rejection of claim 5 as being unpatentable over Bowes in view of English and Rizzardi, the examiner has determined that Rizzardi shows a cap (10) having a peripheral lip with apertures (15) and that it would have been obvious to modify the first member of the Bowes device, as modified by English, to include apertures "to reduce the material and to reduce the cost of manufacture."

(Examiner's Answer, p. 6). We fail to find any motivation, teaching, or suggestion to modify the device of Bowes, as modified by English, to add the apertures of Rizzardi to result in the invention of claim 5.

As shown in Figure 1, Rizzardi relates to a closure for a bottle (5) including a reservoir (2) having an annular edge (6) and a breakable bottom (3). The reservoir (2) is disposed in the neck (4) of the bottle (5). A cylindrical hollow element (8), with its lower end (9) cut sideways, is housed in the reservoir (2). The hollow element (8) is used to break the bottom surface (3) of the reservoir (2) to allow the contents of the reservoir (2) into the bottle (5). (Rizzardi, col. 2, lines 29-42). The closure of Rizzardi also includes a cap (10) that covers the neck (4) of the bottle (5). As shown in Figures 3 and 6, the cap (10) includes cylindrical sections (11 and 12) that are interconnected by connecting bridges (15). (Rizzardi, col. 2, lines 56-58). Apertures are formed in the areas between the adjacent bridges. The connecting bridges (15) are used to facilitate opening of the cap (10) through fracturing of the bridges (15) to separate the two sections (11 and 12) of the cap (10), as described in col. 3, lines 4-16.

We find no teaching, suggestion, or motivation in Rizzardi to add apertures to the annular edge (6) of the reservoir (2). Rather, Rizzardi teaches using apertures only in the cap (10) to facilitate opening. Further, when viewed as a whole, the combined teachings of Bowes, English and Rizzardi, would not have provided a suggestion, teaching, or motivation for one skilled in the art confronted with the problem facing the inventor to have modified Bowes to have added apertures to the peripheral flange (21) of the cup (15) of Bowes. Accordingly, we do not sustain the examiner's rejection of claim 5 under 35 U.S.C. § 103(a).

CONCLUSION

To summarize, the rejection of claims 1, 2, 4 under 35 U.S.C. § 102(b) and the rejection of claim 5 under 35 U.S.C. § 103(a) are not sustained, and the rejection of claims 1-4 under 35 U.S.C. § 103(a) is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED IN PART

CHARLES E. FRANKFORT Administrative Patent Judge	)
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